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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,131	11/25/2003	Masaya Asaine	245779US0	4407
22850	7590	08/23/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			MOORE, MARGARET G	
		ART UNIT	PAPER NUMBER	
		1712		

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	ASAINE, MASAYA	
10/720,131	ASAINE, MASAYA	
Examiner Margaret G. Moore	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 14 June 2005.  
2a) This action is FINAL.                            2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1 to 21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) \_\_\_\_\_ is/are allowed.  
6) Claim(s) 1 to 21 is/are rejected.  
7) Claim(s) \_\_\_\_\_ is/are objected to.  
8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 to 10, 12, 13, 15 and 17 to 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Okinoshima et al.

Okinoshima et al. teach a zinc oxide filled addition curable silicone rubber that is particularly useful as a thermally conductive composition. See for instance lines 18 to 20 on column 2. This composition contains an alkenyl group functional siloxane (col. 3, lines 25 to 33) that meets component (a) as well as particular claims 5 to 8. It also contains a platinum catalyst, see column 7, line 10 and on (particularly teaching the chloroplatinic acid of instant claim 15) and a thermally conductive filler, taught on column 9, line 50, and including the particular fillers of instant claim 2.

Particular attention is drawn to the SiH containing siloxane. Patentees specifically teach siloxanes on column 4, lines 54 and 66 to 67, and column 5, lines 20 to 25, which meet claimed component (c) and claim 21. Since the claimed SiH component is specifically taught by Okinoshima et al., this component is fully anticipated by the prior art. Please note MPEP 2131.02 which indicates that a clearly named species (in the prior art) anticipates a claim no matter who many other species are taught. In this manner each component in the instant claims are fully met by Okinoshima et al. and as such these claims are anticipated.

Note that the SiH siloxanes taught by Okinoshima et al. meet the requirements of instant claims 9 and 10. The limitations of claims 12 and 13 are taught on column 7, lines 6 and 7. Column 11, lines 5 to 10, teaches heat dissipating sheets. With regard to claims 18 to 20, note that these are properties that are inherently associated with the claimed composition. A composition and the properties associated therewith cannot be separated. As such, since the prior art fully meets the chemical composition of claim 1, these properties must inherently be present in the composition of Okinoshima et al.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okinoshima et al.

With regard to claims 11 and 16, note the disclosed value of "L" on column 5 of 1 to 200. This is clearly a shorthand method of teaching the values between 1 to 200 and as such the skilled artisan would immediately envision values of 1, 2, 3, 4... 10, 11, 12...50, 51... 200. From this the selection of a "L" value of from 10 to 50, or even 18, would have been obvious to the skilled artisan since patentees suggest that such a value is operable in the claimed composition.

For claim 14, see the teachings on column 7, lines 35 and 36, which embrace the claimed weight amount of platinum catalyst. The skilled artisan would have been motivated to adjust the amount of platinum catalyst in the composition of Okinoshima et al., in an effort to optimize the curing of the composition, and as such would have found the amount of catalyst claimed obvious and/or within routine experimentation.

The Examiner notes that applicants' one comparative showing is certainly not representative of the totality of the invention. In addition, since only one comparative example is provided, there is nothing to actually indicate that the different results are, in fact, unobvious.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
8/19/05